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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

RICHARDSON, THOMAS W

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,059	Applicant(s) PASTRO ET AL.	
	Examiner THOMAS RICHARDSON	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-46 are pending for examination.

Claims 1-46 are rejected.

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Addition of limitations including incompatible message conversion changes scope of previously examined claims.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz, US 7 620 408, Ye et al, and US 6 714 793, Carey et al.

4. As per claim 1, Wengrovitz teaches an apparatus for performing instant messaging (IM) under a first protocol, said apparatus comprising:

a first device implementing a first protocol (Figure 1, telephone 30);

a second device implementing a second protocol, wherein said first protocol and said second protocol comprise a telephony application protocol and a protocol supporting instant messaging in peer to peer services and at least one of said first device and said second device is a telephone set implementing said telephony application protocol and having a keypad having a fixed number of key buttons and a display (Figure 1, PC 40, also paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols);

Art Unit: 2444

a protocol converter to convert messages between said first device and said second device to/from between said first protocol from/to said second protocol (paragraph 23, where the message is translated for delivery to the telephonic device);

a register to register said first device and said second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions); and

a map to map a first client to said first device and a second client to said second device, said peer to peer services including Instant Messaging (IM) (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions).

Wengrovitz does not expressly teach the first and second protocols being incompatible.

Ye teaches an intelligent messaging system comprising:

a first device implementing a first protocol (column 3, lines 16-24, where multiple devices may be used for multiple communication types);

a second device implementing a second protocol, wherein messages in said first protocol are incompatible with said second protocol and messages in said second protocol are incompatible with said first protocol, and wherein said first protocol and said second protocol comprise a protocol supporting IM in peer to peer services (column 3, lines 16-41, where multiple devices may be used for multiple communication types, including instant messaging, and where the messaging system may convert messages to a format based on the device type);

Art Unit: 2444

a protocol converter to convert incompatible messages between said first device and said second device to/from said first protocol from/to said second protocol, said protocol converter providing IM capability to and managing IM capability for said telephone set (column 3, lines 33-41, where the messaging system may convert messages to a format based on the device type);

a register to register said first device and said second device (column 3, lines 52-58, where the message delivery system may contain information regarding user devices);

a map to map a first client to said first device and said second client to said second device (column 3, lines 52-58, where the message delivery system may contain information regarding user devices, including the ability to convert and send messages from one user to another).

It would have been obvious to utilize a protocol conversion such as taught by Ye in a communication system such as taught by Wengrovitz. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize a protocol conversion with instant messaging such as that taught by Ye, as the protocol conversion allows multiple device types to communicate with each other, and a user to send messages to another user regardless of the device types of the sending and receiving users (column 3, lines 52-58).

Neither Wengrovitz nor Ye expressly teaches the telephone having full IM capability.

Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a telephone with full IM capabilities such as that taught by Carey in a telephone-based instant messaging system such as that taught by Wengrovitz or Ye.

Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). Ye's system allows for mobile devices including cellular phone to utilize instant messaging (column 3, lines 16-24). It would be beneficial in such a system to utilize IM capabilities such as taught by Carey, as the telephone could utilize instant messaging to communicate with the PC-based client.

5. As per claim 2, Wengrovitz further teaches said first protocol is a Session Initiation Protocol (SIP) (paragraph 22, where SIP may be utilized).

6. As per claim 3, Wengrovitz further teaches said second protocol is a Computer Supported Telephony Application (CSTA) and said protocol converter converts between CSTA and SIP/SIMPLE (paragraph 23, where the other device utilizes CSTA and PBX).

7. As per claim 4, Wengrovitz further teaches said first device is a SIP device exchanging SIP/SIMPLE messages with said protocol converter (paragraph 22, where SIP may be utilized by the PC client).

Wengrovitz does not expressly teach utilizing presence information. Carey teaches a cellular instant messaging system comprising:

Art Unit: 2444

managing and determining presence information for a respective IM user (column 5, lines 58-62, where the recipient is determined to be on or off-line).

8. As per claim 5, Wengrovitz further teaches said first device is a PC (Figure 1, PC 40).

9. As per claim 6, Carey further teaches said first device is a PDA (Figure 1, mobile units 36).

10. As per claim 7, Wengrovitz further teaches said second device is said telephone set; said telephone set is a digital telephone, instant messaging being displayed on said display; and said protocol converter further manages IM capability provided to said digital telephone, said PBX exchanging CSTA protocol messages with said protocol converter (Figure 1, telephone 30, also paragraph 37, where IM messages may be displayed).

11. As per claim 8, Wengrovitz further teaches said digital telephone is connected through a telephonic switch (paragraph 31, where the PBX may be part of a PSTN).

12. As per claim 9, Wengrovitz further teaches said telephonic switch is a PBX connected to said protocol converter using CSTA protocol, said CSTA device exchanging CSTA protocol messages with said protocol converter (paragraph 23, where the translator may translate from PBX and CSTA).

Wengrovitz does not expressly teach the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

Art Unit: 2444

full IM capability is provided to said telephone set, full IM capability including composing, retrieving, and responding to messages (column 4, lines 6-33, where the user may create an instant messaging name list).

13. As per claim 10, Wengrovitz further teaches said first device is a CSTA device (paragraph 23, where CSTA may be utilized and translated).

14. As per claim 11, Wengrovitz further teaches said first device is a telephone set and said telephone set is a digital telephone, wherein at least one key button is a programmable key (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a keypad and function buttons).

15. As per claim 12, Wengrovitz further teaches said digital telephone is connected through a telephonic switch monitoring said key buttons and having full control of said display (paragraph 21, where the telephone may have a display and be connected to a PBX , also paragraph 7, where the message may be displayed at the telephone).

16. As per claim 13, Wengrovitz further teaches said telephone switch is a PBX connected to said protocol converter using CSTA (paragraph 23, where the translator may translate from PBX and CSTA).

17. As per claim 14, Wengrovitz teaches a method for supporting Instant Messaging (IM) in digital telephones, comprising the steps of:

registering a first protocol digital telephone set including a display and a keypad having a fixed number of key buttons (Figure 1, telephone 30, also paragraph 21, where the telephone may include a keypad and function buttons);

Art Unit: 2444

converting messages from said first protocol digital telephone set in said first protocol to messages in a second protocol, wherein at said first protocol is a telephony application protocol and said second protocol supports peer to peer services including Instant Messaging (IM) (paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols, and where a message is translated for delivery to the telephone);

mapping an IM identity of a client to said digital telephone set (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions); and

communicating an instant message in one or more converted messages to or from said digital telephone set, instant messaging being displayed on said display (paragraph 21, where the telephone may have a display and be connected to a PBX, also paragraph 7, where the message may be displayed at the telephone).

Wengrovitz does not expressly teach the first and second protocols being incompatible.

Ye teaches an intelligent messaging system comprising:

registering with an internetworking unit a first protocol digital telephone set (column 3, lines 52-58, where the message delivery system may contain information regarding user devices, also column 3, lines 16-24, where multiple devices may be used for multiple communication types, including a cellular phone utilizing instant messaging);

converting in said internetworking unit messages from said first protocol digital telephone set in said first protocol to messages in a second protocol incompatible with

Art Unit: 2444

said first protocol (column 3, lines 33-41, where the messaging system may convert messages to a format based on the device type);

mapping in said internetworking unit an IM identity of a client to said digital telephone set (column 3, lines 52-58, where the message delivery system may contain information regarding user devices, including the ability to convert and send messages from one user to another); and

communicating from/to said internetworking unit an instant message in one or more converted messages to or from said digital telephone set, said internetworking unit providing IM capability to said first protocol digital telephone set (column 3, lines 52-58, where the message delivery system may contain information regarding user devices, also column 3, lines 16-24, where multiple devices may be used for multiple communication types, including a cellular phone utilizing instant messaging).

It would have been obvious to utilize a protocol conversion such as taught by Ye in a communication system such as taught by Wengrovitz. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize a protocol conversion with instant messaging such as that taught by Ye, as the protocol conversion allows multiple device types to communicate with each other, and a user to send messages to another user regardless of the device types of the sending and receiving users (column 3, lines 52-58).

Neither Wengrovitz nor Ye expressly teaches the telephone having full IM capability.

Carey teaches a cellular instant messaging system comprising:

Art Unit: 2444

full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a telephone with full IM capabilities such as that taught by Carey in a telephone-based instant messaging system such as that taught by Wengrovitz or Ye.

Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). Ye's system allows for mobile devices including cellular phone to utilize instant messaging (column 3, lines 16-24). It would be beneficial in such a system to utilize IM capabilities such as taught by Carey, as the telephone could utilize instant messaging to communicate with the PC-based client.

18. As per claim 15, Wengrovitz further teaches registering a second device; wherein said mapping step further maps an IM identity of a second client to said second device and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions, also Figure 1, telephone 30, also paragraph 37, where IM messages may be displayed).

19. As per claim 16, Wengrovitz further teaches mapping a second client to said PC and said instant messaging includes communicating an instant message between said first digital telephone set and said PC (Figure 1, PC 40, also paragraphs 22-23, where

Art Unit: 2444

the second device may utilize SIP, and the first may utilize PBX and CSTA protocols, and where a message is translated for delivery to the telephone).

20. As per claim 17, Wengrovitz further teaches said second device is a Computer Supported Telephony Application (CSTA) digital telephone set; and wherein said converting step also converts messages from said CSTA device to SIP/SIMPLE messages for a SIP device, said mapping step further maps said IM identity of said second client to said second digital telephone set and said communicating step further includes communicating an instant message between said first and said second digital telephone sets (paragraph 22, where SIP may be utilized, also paragraph 23, where the other device utilizes CSTA and PBX, and where the translator may translate from PBX and CSTA).

21. As per claim 18, Wengrovitz further teaches at least one key button is a programmable key, said method further comprising the step of configuring said at least one key button as an Instant Messaging (IM) key for a digital telephone set (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a keypad and function buttons).

22. As per claim 19, Wengrovitz further teaches establishing the IM connection by pressing said instant messaging key (paragraph 21, where the telephone may include a keypad and function buttons).

23. As per claim 20, Wengrovitz further teaches sending a notification to said digital telephone set when a new instant message arrives, said digital telephone set displaying

Art Unit: 2444

a new instant message notification in response (paragraph 34, where the unconsulted messages may be displayed and accessed by the user).

24. As per claim 21, Wengrovitz further teaches instant messaging is accomplished while the digital telephone set is off-hook (paragraph 32, where the message may be delivered while the device is off-hook).

25. As per claim 22, Wengrovitz further teaches composing and displaying instant messages using the standard key buttons and display space of said digital telephone set (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a display, keypad, and function buttons).

26. As per claim 23, Carey further teaches instant messaging includes sending a notification to said digital telephone set when a request to add said digital telephone set client to the contact list of another instant messaging client is received (column 4, lines 6-33, where the user may create an instant messaging name list).

27. As per claim 24, Wengrovitz further teaches using said digital telephone set to sign-in and sign-out for instant messaging services (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions).

28. As per claim 25, Carey further teaches instant messaging includes using said digital telephone set to change the on-line and off-line status of said digital telephone set (column 5, lines 58-62, where the recipient is determined to be on or off-line).

Art Unit: 2444

29. As per claim 26, Carey further teaches communicating includes using said digital telephone set to query the status of a contact list member (column 5, lines 58-62, where the recipient is determined to be on or off-line).

30. As per claim 27, Carey further teaches communicating includes determining the presence status of said digital telephone based on call activity of said digital telephone (column 5, lines 58-62, where the recipient is determined to be on or off-line).

31. Claims 32-46 list all the same elements of claims 1-5, 7-11, and 14-18, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 1-5, 7-11, and 14-18 applies equally as well to claims 32-46.

32. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz, US 7 620 408, Ye et al, and US 6 714 793, Carey et al as applied to claim 14 above, and further in view of US 2005/0013421, Chavez et al.

33. As per claim 28, Wengrovitz does not explicitly teach: instant messaging includes sending stored common replies to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraph 86) the message is saved and then sent as a response.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so,

Art Unit: 2444

by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

34. As per claim 29, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 62 In the same field of endeavor, Chavez teaches, (paragraph 86) the stored text message is a text response created by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

35. As per claim 30, Wengrovitz does not explicitly teach: instant messaging includes sending stored common messages to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraphs 87-88) the stored text message is transmitted in response to the sender.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched

Art Unit: 2444

communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

36. As per claim 31, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 68. In the same field .of endeavor, Chavez teaches, (paragraph 22) stored text messages are associated or mapped to keys, these messages can be customized by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2444

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS RICHARDSON whose telephone number is (571) 270-1191. The examiner can normally be reached on Monday through Thursday, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2444

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TR

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444